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Patrick S. Yoder  
Fletcher, Yoder & Van Someren  
P. O. Box 692289  
Houston, TX 77269-2289

EXAMINER

ROSEN, NICHOLAS D

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/737,874

Applicant(s)

KORITZINSKY ET AL.

Examiner

Nicholas D. Rosen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-14,23,24,26-28,41-53 and 55-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-14,23,24,26-28,41-46,48-53 and 55-58 is/are rejected.
- 7) ☒ Claim(s) 47 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Claims 1-2, 5-14, 23-24, 26-28, and 41-53, and 55-58 have been examined.

***Response to Traversal of Official Notice***

Applicant has traversed Examiner's takings of official notice. In response, Examiner has found prior art documents to justify his assertions of the well-known character of certain features.

In rejecting claims 2, 24, and 53, Examiner took official notice that it is well known for indicia to include textual descriptions of programs or products (e.g., catalog entries). This is supported by Brown et al. (U.S. Patent 5,821,872), column 5, lines 45-60.

In rejecting claim 6, Examiner took official notice that it is well known to store record data. This is supported by Thierrin ("Pen Computers Simplify Projects"), paragraph beginning "Special electronic forms"; and by the anonymous article, "New Software Key to Solving Security Problems," paragraph beginning, "On-line security, in the wake."

In rejecting claim 9, Examiner took official notice that selecting icons, etc., from on-screen menus is well known. This is supported by Bolnick (U.S. Patent 5,838,317), column 18, lines 30-33; by the Microsoft Press Computer Dictionary, pages 303-304; by the anonymous article, "Hewlett-Packard Introduces CD ROM-Based Computer-Performance Management Tool," paragraph beginning "When users are ready"; and by Mallory ("New for PC: Laplink Upgrade").

In rejecting claim 12, Examiner took official notice that it is well known to display indicia based on data (e.g., information in a catalog or products, or icons, titles, etc. on a computer screen indicating what data is in which files). This is supported by Bond et al. (U.S. Patent 5,119,489), Abstract.

In rejecting claim 23, Examiner took official notice that menus in user interfaces are well known, and that displaying indicia descriptive of a product, program, or file is well known. This is supported by Hahn et al. (U.S. Patent 5,751,287), notably Figures 6, 9C, and 10; and by the Microsoft Press Computer Dictionary, pages 303 and 304.

In rejecting claims 26 and 56, Examiner took official notice that it is well known to make selections by actuating a graphical button on an on-screen display. This is supported by Holzinger ("Bulletin Boards' Global Reach"), final paragraph; by the anonymous article, "CARL Corp. Announces Major New Release for Everybody's Menu Builder," paragraph beginning "Everybody's Menu Builder"; and by Lynch et al. (U.S. Patent 5,835,693), column 48, lines 47-49.

In rejecting claim 27 and 57, Examiner took official notice that it is well known to transfer descriptions of products, programs, or files for display. This is supported by Canter ("Internet Search Tools"), paragraph beginning "Internet mania consists"; by Balas ("The Mac Takes its Place in the World of BBS"), paragraph beginning "If you want to read a file description"; and by the anonymous article "'Tapeless' Media at NAB," paragraph beginning "EIA demonstrated."

In rejecting claim 28, Examiner took official notice that it is well known to transfer data, etc., in response to selection from a menu. This is supported by Soultz et al.

("Digital Recording Ammeters Provide Cost-Effective Means for Gathering Line Data"), see abstract and paragraph beginning "Recorded data is transferred"; by the anonymous article, "Hewlett-Packard Introduces CD ROM-Based Computer-Performance Management Tool," paragraph beginning "When users are ready"; by Smith ("Satellite Data Broadcasting – an End to the World-Wide-Wait?"), Abstract; and by Mallory ("New for PC: Laplink Upgrade"), paragraph beginning "Laplink allows users."

In rejecting claim 41, Examiner took official notice that it is well known to view lists of items on a user interface, and select a desired item from a list. This is supported by Johnson et al. (U.S. Patent 5,694,616), column 1, lines 15-22, and column 3, lines 6-26; and by Vela et al. (U.S. Patent 5,630,068), column 2, lines 55-61.

In rejecting claim 55, Examiner took official notice that menus for selecting items from are well known. This is supported by Smith ("Satellite Data Broadcasting – an End to the World-Wide-Wait?"), Abstract; by the anonymous article, "Hewlett-Packard Introduces CD ROM-Based Computer-Performance Management Tool," paragraph beginning "When users are ready"; by Panepinto ("Make Room, EDI"), paragraph beginning "Users can fax documents"; and by the Microsoft Press Computer Dictionary, pages 303 and 304.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### **Claims 1-2, 5-6, 8, and 14**

Claims 1-2, 5-6, 8, and 14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 59-64 and 67 of copending Application No. 09/476,708. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application recites, in essence, the limitations of claims 59 and 62 of the '708 application, without any new limitations. Claim 2 of the instant application adds the same limitation as claim 64 of the '708 application. Claim 5 of the instant application adds, in essence, the limitations of claim 61 of the '708 application. Claim 6 of the instant application adds, in essence, the limitations of claims 59 and 60 of the '708 application. Claim 8 of the instant application adds, in essence, the limitations of claim 63 of the '708 application. Claim 14 of the instant application adds the same limitation as claim 67 of the '708 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Claims 41-44**

Claims 41-45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 69-72 and 62 of copending Application No. 09/476,708. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 41 of the instant application recites, in essence, the same limitations as claim 69 of the '708 application, in combination with claim 62 of the '708 application. Claim 42 of the instant application adds the same limitations as claim 70 of the '708 application. Claim 43 of the instant application adds the same limitations as claim 71 of the '708 application. Claim 44 of the instant application adds the same limitations as claim 72 of the '708 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Claims 46 and 48-50**

Claims 46 and 48-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 46-50 of U.S. Patent No. 6,272,469 in view of Wyman (U.S. Patent 5,260,999). Although the conflicting claims are not identical, they are not patentably distinct because claim 46 recites a system for carrying out the method of claim 1 of the '469 patent, with the additional feature of a license module for verifying a subscription status regarding the first and second protocols, while claims 48-50 are parallel to claims 2-4, respectively, of the '469 patent. The claims of the '469 patent do not recite a license module for verifying a subscription status regarding the first and second protocols, but Wyman

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teaches a license module for verifying a subscription status of a site seeking to use a program (column 6, line 43, through column 7, line 40). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include a license module for verifying a subscription status regarding the protocols, for the obvious advantages of avoiding providing protocols to users who have not paid for subscriptions, and checking protocols downloaded against subscribers, particularly in the case of what Wyman terms a consumptive style, where a subscription allows only a limited number of downloads.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-2 and 5-14**

Claims 1, 5, 10, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 5,891,035) in view of Wyman (U.S. Patent 5,260,999). As per claim 1, Wood discloses a method for providing operational protocols to medical diagnostic systems, the method comprising the steps of storing a protocol on a machine readable medium (column 2, lines 8-19 and 30-49; column 7, lines 1-43); displaying user viewable indicia descriptive of the protocol at a medical diagnostic location (column 2, lines 8-19 and 30-49; column 7, line 1, through column 8, line 4); selecting the protocol via a user interface (Figure 3; column 7, line 1, through column 8, line 4); and loading the protocol at the medical diagnostic location from the machine readable medium (Figure 3; column 7, line 1, through column 8, line 4). Wood does not disclose verifying a subscription status for the diagnostic location, but Wyman teaches verifying a subscription status of a site seeking to use a program (column 6, line 43, through column 7, line 40). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to verify a subscription status for the diagnostic location, for the obvious advantages of avoiding providing protocols to users who have not paid for subscriptions, and checking protocols downloaded against subscribers, particularly in the case of what Wyman terms a consumptive style, where a subscription allows only a limited number of downloads.

As per claim 5, Wyman teaches transmitting an authorization prompt to the site based upon the verification of subscription status (column 6, line 43, through column 7, line 2). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to transmit an authorization prompt to the medical diagnostic

location based upon the verification of the subscription status, for the obvious advantage of enabling the loading of the protocol to be confirmed as authorized, and thus to take place.

As per claim 10, Wood discloses transferring at least one configuration parameter based upon the protocol to a scanner controller for execution of the protocol (column 7, lines 34-58; Figure 3).

As per claim 11, Wood discloses that the machine readable medium includes a memory device remote from the medical diagnostic location (column 2, lines 8-19 and 30-49; column 6, line 15, through column 7, line 33).

As per claim 14, Wood does not quite expressly disclose that the protocol includes data for filming, viewing, reconstructing or processing images reconstructed from image data, but this is implied by Wood's disclosure of image transmission (column 7, lines 1-9; column 8, lines 5-23). Without means for reconstructing and viewing the image data, it is difficult to understand the purpose of transmitting image data.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 5,891,035) and Wyman (U.S. Patent 5,260,999) as applied to claim 1 above, and further in view of official notice. Wood does not expressly disclose that the user viewable indicia include a textual description of the protocol, although Wood's words at column 7, lines 27-33, and column 7, line 59, through column 8, line 4 are quite suggestive. It appears improbable that a user of Wood's system would download a protocol new to the user with no textual description of the protocol; even in the case of

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a protocol familiar to the user, a textual description would be helpful for identifying the protocol, distinguishing it from other available protocols, and reminding the user exactly what it did. In any event, official notice is taken that it is well known for indicia to include textual descriptions of programs or products (e.g., catalog entries). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have the user viewable indicia include a textual description of the protocol, for the obvious advantage of enabling the user to conveniently acquire information about the protocol.

Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood and Wyman as applied to claim 1 above, and further in view of official notice. As per claim 6, Wood does not expressly disclose storing record data indicative of the selection and loading of the protocol, but official notice is taken that it is well known to store record data. Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to store record data indicative of the selection and loading of the protocol, for such obvious advantages as confirming what protocol had been used, whether the protocol had been fully loaded, and resolving any disputes regarding payment for the protocol.

As per claim 8, Wyman teaches that subscriptions are time-expiring subscriptions (column 27, lines 4-11; note also references to "duration" in Abstract and column 7, lines 3-40). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention for the record data to include data representative of a time-

expiring subscription, for the obvious advantage of avoiding the unwanted giveaway of protocols for which a subscription had expired.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood, Wyman, and official notice as applied to claim 6 above, and further in view of Reeder (U.S. Patent 5,852,812). Wood does not disclose that record data includes financial record data for invoicing the medical diagnostic location for the protocol, but Reeder teaches storing financial record data for invoicing a user for transactions, such as downloading a file (column 14, lines 27-42). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have the record data include financial record data for invoicing the medical diagnostic location for the protocol, for the stated advantage of billing for file downloading.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 5,891,035) and Wyman (U.S. Patent 5,260,999) as applied to claim 1 above, and further in view of official notice. Wood does not expressly disclose that selecting the protocol includes selecting a graphical interface device of an on-screen menu, but official notice is taken that selecting icons, etc., from on-screen menus is well known. Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have the step of selecting the protocol include selecting a graphical interface device of an on-screen menu, for the obvious advantage of enabling users to select a protocol in a standard way, likely to be familiar and easily understandable to many users.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 5,891,035) and Wyman (U.S. Patent 5,260,999) as applied to claim 1 above, and further in view of official notice. Wood does not expressly disclose accessing product configuration data representative of a hardware or software configuration of a medical diagnostic system, and displaying the indicia based on the configuration data. However, Wood discloses accessing product configuration data controlling the hardware or software configuration of a medical diagnostic system (column 2, lines 8-19 and 30-49; column 7, line 1-58), and discloses a user choosing configuration data (column 7, lines 1-58). Official notice is taken that it is well known to display indicia based on data (e.g., information in a catalog or products, or icons, titles, etc. on a computer screen indicating what data is in which files). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to display indicia based upon the configuration data, for the obvious advantage of telling users which files, etc., contain which configuration data.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 5,891,035) and Wyman (U.S. Patent 5,260,999) as applied to claim 1 above, and further in view of Narayanaswami et al. (U.S. Patent 6,504,571). Wood does not disclose that the indicia are sortable by image parameters, but Narayanaswami teaches sorting by image parameters (Abstract; column 1, line 7, through column 2, line 6). Hence it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have the indicia be sortable by image

parameters, for the obvious advantage of aiding a user in finding images relevant to his current needs.

### **Claims 23-24 and 26-28**

Claims 23-24 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 5,891,035) in view of Wyman (U.S. Patent 5,260,999) and official notice. As per claim 23, Wood discloses a method for providing an operational protocol for a medical diagnostic system. The method comprising the steps of: storing the protocol on a machine readable medium (column 2, lines 8-19 and 30-49; column 7, lines 1-43); selecting a protocol (column 7, line 1, through column 8, line 4; Figure 3); and transmitting data defining at least one operational parameter from the machine readable medium to a system controller for execution of the protocol (column 7, lines 34-58; Figure 3). Wood does not disclose verifying a subscription status for the diagnostic location thereby allowing access to the protocol, but Wyman teaches verifying a subscription status of a site seeking to use a program thereby allowing access to the program (column 6, line 43, through column 7, line 40). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to verify a subscription status for the diagnostic location thereby allowing access to the protocol, for the obvious advantages of avoiding providing protocols to users who have not paid for subscriptions, and checking protocols downloaded against subscribers, particularly in the case of what Wyman terms a consumptive style, where a subscription allows only a limited number of downloads.

Wood does not expressly disclose displaying indicia descriptive of the protocol in a protocol menu of a user interface, or selecting the protocol from the menu. However, official notice is taken that menus in user interfaces are well known, and that displaying indicia descriptive of a product, program, or file is well known. Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to display indicia descriptive of the protocol in a protocol menu of a user interface, and select the protocol from the menu, for the obvious advantage of enabling users to conveniently obtain information about protocols, and select a desired protocol, by common, well-known means likely to be familiar to users.

As per claim 24, Wood does not expressly disclose that the indicia include a textual description of the protocol, although Wood's words at column 7, lines 27-33, and column 7, line 59, through column 8, line 4 are quite suggestive. It appears improbable that a user of Wood's system would download a protocol new to the user with no textual description of the protocol; even in the case of a protocol familiar to the user, a textual description would be helpful for identifying the protocol, distinguishing it from other available protocols, and reminding the user exactly what it did. In any event, official notice is taken that it is well known for indicia to include textual descriptions of programs or products (e.g., catalog entries). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have the indicia include a textual description of the protocol, for the obvious advantage of enabling the user to conveniently acquire information about the protocol.

As per claim 26, Wood does not expressly disclose that the step of selecting includes actuation of a graphical button on an on-screen display, but official notice is taken that it is well known to make selections by actuating a graphical button on an on-screen display. Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have the step of selecting include actuation of a graphical button on an on-screen display, for the obvious advantage of enabling users to select a protocol conveniently by common, well-known means likely to be familiar to users.

As per claim 27, Wood discloses an establishing a network link between the diagnostic system and a remote service facility (Figures 1 and 2; column 4, line 66, through column 4, line 38). Wood does not expressly disclose transferring a description of the protocol from the service facility to the diagnostic system for display in the menu, but official notice is taken that it is well known to transfer descriptions of products, programs, or files for display. Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to transfer a description of the protocol from the service facility to the diagnostic system for display in the menu, for the obvious advantage of conveniently enabling a user to learn the features of the protocols before selecting an appropriate protocol.

As per claim 28, Wood discloses an establishing a network link between the diagnostic system and a remote service facility (Figures 1 and 2; column 4, line 66, through column 6, line 38), and discloses transferring data defining the protocol from the service facility to the diagnostic system (column 7, lines 1-52). Wood does not

expressly disclose transferring data defining the protocol from the service facility to the diagnostic system in response to selection of the protocol from the menu, but official notice is taken that it is well known to transfer data, etc., in response to selection from a menu. Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to transfer data defining the protocol from the service facility to the diagnostic system in response to selection of the protocol from the menu, for the obvious advantage of conveniently enabling users to obtain the data, using standard features likely to be familiar to users.

#### **Claims 41-45**

Claims 41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 5,891,035) in view of Wyman (U.S. Patent 5,250,999) and official notice. As per claim 41, Wood discloses a method for obtaining an operational protocol in a medical diagnostic system, the method comprising the steps of establishing a network link with a remote protocol library (Figures 1 and 2; column 4, line 66, through column 6, line 38); accessing data from the protocol library defining the desired protocol (column 7, lines 1-46); and transmitting the data from the library to the diagnostic system (column 7, lines 1-46). Wood does not disclose verifying a subscription status for access to the protocol, but Wyman teaches verifying a subscription status for access to a program (column 6, line 43, through column 7, line 40). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to verify a subscription status for access to the protocol, for the obvious advantages of avoiding providing protocols to users who have not paid for

subscriptions, and checking protocols downloaded against subscribers, particularly in the case of what Wyman terms a consumptive style, where a subscription allows only a limited number of downloads.

Wood does not expressly disclose viewing a protocol list on a user interface at the medical diagnostic system; and selecting a desired protocol from the list. However, Wood does disclose selecting a desired protocol (column 7, line 1, through column 8, line 4), and official notice is taken that it is well known to view lists of items on a user interface, and select a desired item from a list. Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to view a protocol list on a user interface at the medical diagnostic system, and to select a desired protocol from the list, for the obvious advantage of enabling the user to select a desired protocol in a convenient way likely to be familiar to users.

As per claim 43, Wood does not disclose transmitting data descriptive of the protocol to the medical diagnostic system for addition to the protocol list, but does disclose the user selecting a protocol (column 7, line 1, through column 8, line 4), from which the availability of data describing the protocols is held to be obvious. Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to transmit descriptive of the protocol to the medical diagnostic system for addition to the protocol list, for the obvious advantage of making it practical for users to know that the protocol was available, and what the protocol was good for.

Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood, Wyman, and official notice as applied to claim 41 above, and further in view of the

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admitted prior art. Wood contains no indication that the protocol list includes protocols for anything except a modality of the medical diagnostic system (ultrasound), from which it is held to be obvious for the protocol list to include only protocols for a modality of the medical diagnostic system. Wood does not disclose that the library includes protocols for a plurality of diagnostic system modalities, but it is admitted prior art that there are a plurality of diagnostic system modalities with respective protocols (the instant application, page 1, line 22, through page 2, line 25). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention for the library to include protocols for a plurality of diagnostic system modalities, for the obvious advantage of enabling users of a plurality of diagnostic systems to obtain suitable protocols.

Claims 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood, Wyman, and official notice as applied to claim 41 above, and further in view of Reeder (U.S. Patent 5,852,812). As per claim 44, Wood does not disclose authorizing a fee for the protocol, but Reeder teaches charging a fee for downloading a file (column 14, lines 25-42), from which authorizing a fee is held to be obvious, since attempting to charge people fees which they have in no way authorized would in many cases lead to complaints, refusal to pay, and possible litigation or prosecution. Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to authorize a fee for the protocol, for the obvious advantage of collecting fees without these difficulties.

As per claim 45, Reeder discloses updating a fee file (column 14, lines 25-42). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to update a fee file in response to authorization of the fee, for the obvious advantage of billing users fully for their downloading of protocols.

**Claims 51-53 and 55-58**

Claims 51, 52, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 5,891,035) in view of Wyman (U.S. Patent 5,260,999). As per claim 51, Wood discloses a method for providing an operational protocol for a medical diagnostic system, the method comprising the step of: storing the protocol on a machine readable medium (column 2, lines 8-19 and 30-49; column 7, lines 1-43\*). Wood does not expressly disclose transmitting a description of the protocol to a medical diagnostic system; and displaying the description of the protocol at the medical diagnostic system. However, Wood discloses transmitting the protocol to a medical diagnostic system (column 7, lines 1-58), and discloses the user selecting appropriate protocols (column 7, line 1, through column 8, line 4). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to transmit a description of the protocol to a medical diagnostic system and display the description of the protocol at the medical diagnostic system, for the obvious advantage of enabling the user to know that the protocol was available, and what the protocol was good for.

Wood does not disclose verifying a subscription status for access to the protocol, but Wyman teaches verifying a subscription status for access to a program (column 6, line 43, through column 7, line 40). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to verify a subscription status for access to the protocol, for the obvious advantages of avoiding providing protocols to users who have not paid for subscriptions, and checking protocols downloaded against subscribers, particularly in the case of what Wyman terms a consumptive style, where a subscription allows only a limited number of downloads.

As per claim 52, Wood discloses transmitting data defining at least one operational parameter from the machine readable medium to a system controller for execution of the protocol (column 7, lines 34-58; Figure 3).

As per claim 58, Wood discloses an establishing a network link between the diagnostic system and a remote service facility (Figures 1 and 2; column 4, line 66, through column 6, line 38), and discloses transferring data defining the protocol from the service facility to the diagnostic system in response to selection of the protocol at the diagnostic system (column 7, lines 1-52).

Claims 53 and 55-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood and Wyman as applied to claim 51 above, and further in view of official notice. As per claim 53, Wood does not expressly disclose that the description includes a textual description of the protocol, although Wood's words at column 7, lines 27-33, and column 7, line 59, through column 8, line 4 are quite suggestive. It appears improbable that a user of Wood's system would download a protocol new to the user

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with no textual description of the protocol; even in the case of a protocol familiar to the user, a textual description would be helpful for identifying the protocol, distinguishing it from other available protocols, and reminding the user exactly what it did. In any event, official notice is taken that it is well known for descriptions to include textual descriptions of programs or products (e.g., catalog entries). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have the description include a textual description of the protocol, for the obvious advantage of enabling the user to conveniently acquire information about the protocol.

As per claim 55, Wood does not expressly disclose selecting the protocol from a protocol menu displayed at the diagnostic system, but official notice is taken that menus for selecting items from are well known (see, for example, the Microsoft Press Computer Dictionary, pages 303-304). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the step of selecting the protocol from a protocol menu displayed from a protocol menu displayed at the diagnostic system, for the obvious advantage of enabling users of the diagnostic system to conveniently select a desired protocols, by common, well-known means likely to be familiar to users.

As per claim 56, Wood does not expressly disclose that the selecting step includes actuation of a graphical button on an on-screen display, but official notice is taken that it is well known to make selections by actuating a graphical button on an on-screen display. Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have the selecting step include actuation of a

graphical button on an on-screen display, for the obvious advantage of enabling users to select a protocol conveniently by common, well-known means likely to be familiar to users.

As per claim 57, Wood discloses an establishing a network link between the diagnostic system and a remote service facility (Figures 1 and 2; column 4, line 66, through column 4, line 38). Wood does not expressly disclose transferring a description of the protocol from the service facility to the diagnostic system for display, but official notice is taken that it is well known to transfer descriptions of products, programs, or files for display. Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to transfer a description of the protocol from the service facility to the diagnostic system for display, for the obvious advantage of conveniently enabling a user to learn the features of the protocols before selecting an appropriate protocol.

#### ***Allowable Subject Matter***

Claim 46-50 would be allowable upon filing of a valid Terminal disclaimer.  
(Claims 46, 48, 49, and 50 are rejected due to double patenting; claim 47 is objected to as dependent on a rejected claim).

The following is a statement of reasons for the indication of allowable subject matter: the closest prior art of record, Wood et al. (U.S. Patent 5,891,035), discloses a system for providing operational protocols to a plurality medical diagnostic scanners, the system comprising: at least one storage device for storing data defining protocols; and

communications circuitry for establishing network links to diagnostic systems. A messaging module for formulating messages containing data descriptive of protocols, and communication circuitry for transmitting such descriptive data are held to be obvious in view of Wood. Wood does not disclose a license module for verifying a subscription status regarding the first and second protocols, but license modules are well known (see, for example, Wyman, U.S. Patent 5,260,999). Different modality diagnostic systems (such as the ultrasound systems disclosed by Wood, and also x-ray, magnetic resonance imaging, etc. systems) are known (and admitted prior art; see pages 1 and 2 of the instant application). However, neither Wood nor any other prior art of record discloses, teaches, or reasonably suggests establishing network links to first and second modality diagnostic systems, and transmitting data descriptive of a first modality protocol to the first modality diagnostic system, and data descriptive of a second modality protocol to the second modality diagnostic system.

### ***Response to Arguments***

Applicant's arguments filed April 15, 2003, have been fully considered but they are not persuasive. First, with regard to the double patenting rejections, Applicant's amendments have necessitated modifying the rejections, but not withdrawing them, since claim 46 and its dependents are now patentably distinct from claims 1-4 of U.S. Patent 6,272,469, but rejected as unpatentable in view of a secondary reference (Wyman, U.S. Patent 5260,999). Similarly, the provisional obviousness-type double

patenting rejections against various other claims have been modified in view of Applicant's amendments, but not withdrawn.

Examiner's previous rejections under 35 U.S.C. 102 have been overcome by amendment, but only to the extent of becoming obviousness rejections under 35 U.S.C. 103. While Wood (U.S. Patent 5,891,035) does not disclose verifying a subscription status for the diagnostic location, Wyman (U.S. Patent 5,260,999) as set forth above, teaches verifying a subscription status for a location. Applicant disputes the validity of rejections based on the combination of Wood and Wyman on the basis that Wyman does not teach diagnostic locations or protocols for medical diagnostic equipment, but instead discusses the use of spreadsheet programs, and also because Wyman does not teach loading protocols, or other software, but verifying a license so as to allow software already on the computer to be employed. Examiner responds that Wyman merely mentions spreadsheet programs as an example in his "Background of the Invention" section, but nowhere suggests (and definitely not in his claims) that his method of managing the usage of software items is limited to spreadsheets.

In response to Applicant's argument regarding Wyman's lack of teaching the loading of a protocol, this deficiency does not make the claims patentable, since Wood does disclose loading a protocol, and the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*,

642 F.2d 413, 208 USPQ 871 (CCPA 1981). Wyman is relied upon only for verifying the subscription status of a location (and transmitting an authorization prompt, and subscriptions being time-expiring subscriptions); verifying the subscription status of a site would have suggested to those of ordinary skill in the art modifying Wood to verify the subscription status of medical diagnostic locations, for the motivation of providing such information as diagnostic protocols only to those with subscriptions. Those skilled in the art, or even moderately familiar with controversies relating to the protection of intellectual property, political lobbying and litigation, attempted technological fixes, etc., would be aware of the desire of sellers of information to restrict their products to those who have paid for it as a potent motivation.

In response to Applicant's request to provide references supporting Examiner's contentions of obviousness of obviousness, Examiner has now done so.

Applicant accuses Examiner of contending that a number of features recited in claims 3 and 14 are "obvious" without references to support the contention, and asserts that, essentially, Examiner has taken official notice. Examiner disagrees, and replies that features not explicit in Wood are obvious (arguably even inherent). In rejecting claim 14 (which is more relevant than claim 3, which has been canceled), Examiner wrote: "Wood does not quite expressly disclose that the protocol includes data for filming, viewing, reconstructing or processing images reconstructed from image data, but this is implied by Wood's disclosure of image transmission (column 7, lines 1-9; column 8, lines 5-23). Without means for reconstructing and viewing the image data, it is difficult to understand the purpose of transmitting image data." Unless Applicant can

provide reasons why it would be plausible for Wood's invention to include the transmission of images which the users of his invention would then be unable to film, view, reconstruct, or process, Examiner will remain of the opinion that his statement of obviousness was justified. Moreover, the rejection was not equivalent to a taking of official notice, since Examiner did not assert that it is well known in general to include data for filming, viewing, reconstructing or processing images (although that may be), but that Wood's own disclosure implied what it did not explicitly teach.

Applicants assert that there is no reason to believe that Narayanaswami et al. (U.S. Patent 5,981,035) obviates the alleged deficiencies of Wood and Wyman discussed above. Examiner responds that that is beside the point, since Narayanaswami was not relied upon to do so, but to teach sorting by image parameters.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). To recapitulate, it was known to those of ordinary skill at the time of Applicant's invention to verify the subscription status of a site, as taught by Wyman, and the other features of claim 1 in particular are disclosed by Wood; it is of little import that Wyman does not teach *loading* the protocol, when Wood does.

In response to applicant's argument that Wyman is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, it is proper to point out that despite Applicant's repeated use of the word "*spreadsheet*" in italics, Wyman is in no way limited to spreadsheet programs, but merely mentions spreadsheet programs as one example of the kind of situation to which it would be advantageous to apply his invention, in one paragraph of the Background section. The Wyman reference is not in the field of spreadsheets, but in the field of software licensing (Wyman is classified in class 705, subclass 59 by the Patent Office). This is not quite the field of medical diagnostic systems, but it may be observed that Applicant's invention does not pertain primarily to medical diagnostic systems as such (Applicant is not the inventor of magnetic resonance imaging, and the instant application does not disclose or claim some particular new technique for using ultrasound); instead, the instant application recites providing operational protocols to medical diagnostic systems, and this is analogous to providing other information, such as computer programs, digitized music, etc. All of these are made up of 1's and 0's, and in each case, similar issues arise of making the information available to users, with similar motivations to make the information available only to those users who have paid for it, or are otherwise properly authorized. For this reason, Wyman is held to be reasonably pertinent to the particular problem with which the applicant was concerned. Wyman does, as Applicant

writes, teach calling a center to determine whether software already loaded on a computer is properly licensed, rather than loading software from a center to a computer, but it may be observed that claim 1 only recites "verifying a subscription status for the diagnostic location," without specifying how this is done, and that Wyman is relied on only to teach verifying, not loading the protocol, which is already disclosed by Wood, the primary reference.

Applicant's arguments regarding claim 23 and its dependents, claim 41 and its dependents, and claim 51 and its dependents are essentially similar to those made regarding claim 1 and its dependents (and not set forth at such length). Examiner will therefore not respond in detail, but simply note that his defense of the rejections of claims 1-2 and 5-14 is also applicable the other claims rejected under 35 U.S.C. 103.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bond et al. (U.S. Patent 5,119,489) disclose a method of monitoring the bring-up of all units in a multiple system from a remote unit, including diagnostic testing with visual indicator illumination indicating operability. Vela et al. (U.S. Patent 5,630,068) disclose a shoppers communication system and process relating thereto. Johnson et al. (U.S. Patent 5,694,616) disclose a method and system for prioritization of email items by selectively associating a priority attribute with at least one and fewer than all of the recipients. Hahn et al. (U.S. Patent 5,751,287) disclose a system for organizing document icons with suggestions, folders, drawers, and cabinets.

Brown et al. (U.S. Patent 5,821,872) disclose an information display apparatus. Lynch et al. (U.S. Patent 5,835,693) disclose an interactive system for simulation and display of multi-body systems in three dimensions. Bolnick et al. (U.S. Patent 5,838,317) disclose a method and apparatus for arranging displayed graphical representations on a computer interface. Yamada (U.S. Patent 6,512,841) discloses an image processing system.

The anonymous article, "Hewlett-Packard Introduces CD ROM-Based Computer-Performance Management Tool," discloses selecting information from a menu, to have the specified information transferred from a host system to a user's PC. Soultz et al. ("Digital Recording Ammeters Provide Cost-Effective Means for Gathering Line Data") disclose, inter alia, selecting a menu item to have data transferred to a user's PC. Moser ("Beta Users hail Interface, Robust Performance of dBASE IV 1.5") discloses letting users build and modify searches by selecting items from a menu. Mallory ("New for PC: Laplink Upgrade") discloses an upgrade to Laplink, a utility program that enables users to transfer files using pull down menus to select functions. Balas ("The Mac Takes Its Place in the World of BBS") discloses, inter alia, displaying file descriptions. Panepinto ("Make Room, EDI") discloses new communications technology, including having users fax documents by selecting items off their e-mail menus. Pearlstein ("On the Air 1.0.1") discloses a communication system as easy as selecting an item from a menu. The anonymous article, "'Tapeless' at NAB," discloses, inter alia, transmitting program titles for display. Holzinger ("Bulletin Boards' Global Reach") discloses "pushing" graphical buttons. Thierrin ("Pen Computers Simplify

Projects”) discloses pen computers, which store data records. The anonymous article, “New Software Key to Solving Security Problems,” discloses storing records of downloaded files. Canter (“Internet Search Tools”) discloses, inter alia, a file transfer utility with the ability to display file descriptions. The anonymous article, “CARL Corp. Announces Major New Release for Everybody’s Menu Builder,” discloses clicking on graphical buttons. Smith, “Satellite Data Broadcasting – an End to the World-Wide-Wait?” (Abstract only) discloses consumers consulting an on-screen menu for data, and then selecting information to receive.

Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and for After Final communications. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

The new mailing address for the Patent Office is:

Commissioner for Patents

P.O. Box 1450

Alexandria VA 22313-1450

As of May 1, 2003, the former addresses, Washington DC 20231 and P.O. Box 2327 Arlington VA 22202, should **not** be used.

Papers can be hand-delivered to the Technology Center 3600 receptionist, 7<sup>th</sup> floor, Crystal Park 5, 2451 Crystal Drive, Arlington VA 22202.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

*Nicholas D. Rosen*  
Nicholas D. Rosen  
Primary Examiner  
June 3, 2003